

**REMARKS:**

Claims 1-31 are currently pending in the application.

Claims 32-50 have been previously canceled without *prejudice*.

Claims 1-10 stand rejected under 35 U.S.C. § 101.

Claims 1-31 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-31 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 20020046294 A1 to Brodsky et al. (hereinafter "*Brodsky*") in view of U.S. Patent No. 7,039,597 to Notani et al. (hereinafter "*Notani*")

Applicants note with thanks the Examiner's response of 9 July 2010. Applicants further note with thanks the Examiner's withdrawal of the 35 U.S.C. § 102(e) over *Brodsky*.

Applicants respectfully submit that all of Applicants arguments are without *prejudice* or *disclaimer*. In addition, Applicants have merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicants reserve the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicants further respectfully submit that by not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are considered sufficient to overcome the Examiner's rejections. In addition, Applicants reserve the right to pursue broader claims in this Application or through a continuation patent application.

**I. Rejections Under 35 U.S.C. § 101**

Claims 1-10 stand rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. Applicants respectfully traverse the examiner's rejections and respectfully submit that Claims 1-10 are directed toward statutory subject matter.

In rejecting Claims 1-10, the Examiner states the following:

Claims 1-10 are rejected under 35 U.S.C. 101 because it claims a negotiation system which is a computer program claimed as software per se, i.e., the descriptions or expressions of the programs, are not physical things. They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. The system as claimed merely is configured to store various pieces of information but doesn't specifically perform any of the listed tasks. Further, since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and is nonstatutory functional descriptive material. Since the process is non functional descriptive material none of the steps are positively recited thus the prior art merely needs to be configured to perform the steps. (9 July 2010 Non-Final Office Action, pages 7-8).

Title 35 U.S.C. § 101 provides that patents may be obtained for "any new and useful process, machine, manufacture, or composition of matter." Applicants' independent Claim 1 recites "a storage medium having a set of one or more predefined meta-model elements stored therein," and "a storage medium having a meta-model negotiation service stored therein."

A "storage medium," or memory, as claimed in pending Claim 1 is, at a minimum, a manufacture. Therefore, Claim 1 is directed to statutory subject matter. Thus, Applicants respectfully request that the rejection of Claim under 35 U.S.C. § 101 be withdrawn.

Likewise, dependent claims 2-10 depend from Claim 1 and are therefore also directed to statutory subject matter. Thus, Applicants respectfully request that the rejection of Claims 1-10 under 35 U.S.C. § 101 be withdrawn.

## **II. Rejection Under 35 U.S.C. § 112, Second Paragraph**

Claims 1-31 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Applicants respectfully disagree and respectfully traverse the Examiner's rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph.

In particular, the Examiner states the following:

Regarding claims 1-31, the phrase "meta-model" renders the claim indefinite because it is unclear what the applicant means to be a meta-model. The applicant states in the specification that a "meta-model" describes a trade partner agreement. The examiner is reading meta-model to mean a description of the structure of what data fields are included in the agreement. Such as the uses in EDI and DTD.

(9 July 2010 Non-Final Office Action, page 8). Applicants respectfully disagree with the Examiner's assertion that the claims are indefinite and thus, one of ordinary skill in the art at the time the application was filed would not understand the term "meta-model" in such a way as to be able to make and use the invention. Applicants respectfully submit that references to the use of the term "meta-model" in Applicants' specification already made of record is more than sufficient to distinctly claim the subject matter so as to be clear to one of ordinary skill in the art as to what the claimed invention entails.

Furthermore, if Examiner continues to contest Applicants' position that "meta-model" is a term that was commonly known in the art at the time of the invention, Applicants respectfully request the Examiner refer to the plethora of other patents and publications dated prior to the filing date of the subject application that employ this term. Thus, the term "meta-model" was known to one of ordinary skill in the art at the time of the invention.

Thus, for at least the reasons detailed above, Applicants respectfully request that the rejection of Claims 1-31 under 35 U.S.C. §112, second paragraph, be withdrawn.

### **III. Rejections Under 35 U.S.C. § 103(a)**

Claims 1-31 stand rejected under 35 U.S.C. § 103(a) over *Brodsky* and *Notani*.

Applicants respectfully submit that Applicants' claims in their current form contain unique and novel limitations that are not disclosed by *Brodsky* and *Notani* whether taken individually or in combination. Thus, Applicants respectfully traverse the Examiner's anticipation obviousness rejection of Claims 1-31 under 35 U.S.C. § 103(a) over *Brodsky* and *Notani*, individually or in combination.

In rejecting Claim 1, the Examiner states the following:

Brodsky does not specifically teach wherein the meta-models are predefined or newly defined. However, Notani teaches receive selection of one or more of the predefined meta-model elements and one or more meta-model elements is newly defined by at least one of the enterprises (col. 2, line 35 - col. 3, line 20, col. 18, lines 5-53). (9 July 2010 Non-Final Office Action, page 10).

Applicants thank the Examiner for noting the shortcomings of *Brodsky* but respectfully disagree with the Examiner's assertions and respectfully direct the Examiner's attention to column 18, lines 5-53 of the specification of *Notani*, provided below, on which the Examiner relies:

#### Extension of Framework

An important aspect of the present framework is extensibility. Without extensibility, the framework may not be able to handle new situations and challenges with which it is confronted. There can be several different dimensions to this extensibility. For example, ***one primary area of extensibility is in the area of semantic object standards. If supported standards do not suffice for a particular problem, then the framework can be augmented with new semantic standards. Additionally the framework allows the building of proprietary semantic standards. Further, the framework can be extended by adding new accessors, transformers, adapters, etc.***

#### Collaboration Management

The present invention may provide for management of collaborations within and between enterprises. Generally described, the present invention may provide a computer implemented process for managing workflows and collaborations distributed between nodes of one or more enterprises. The computer implemented process manages a collaboration by storing a set of predefined functions for the collaboration to be performed at the distributed nodes. The computer implemented process automatically interacts with the collaboration at each of the nodes to perform the predefined functions. As used herein, "each" means at least a subset of the identified items. ***The computer-implemented process may be a high-level collaboration generated and processed by the global collaboration designer and the global collaboration manager as previously described in connection with other collaborations of the system or other suitable process capable of managing a collaboration across multiple nodes.***

The predefined functions may be functions for generating, deploying, monitoring, or otherwise interacting with a collaboration.

FIG. 19 illustrates a flow diagram for generating a collaboration between a plurality of enterprises in accordance with one embodiment of the present

invention. Referring to FIG. 19, the method for generating a collaboration begins at step **160** at which a preliminary collaboration is received from a first enterprise. ***The collaboration is preliminary in that it may be commented upon or modified by other enterprises involved in the collaboration.*** The preliminary collaboration may be generated or otherwise provided by the first enterprise. (Emphasis added).

As shown above, the portions of *Notani* on which the Examiner relies fails to disclose at least the element of Claim 1 of ***“receiv[ing] selections of one or more of the predefined meta-model elements and one or more meta-model elements that is newly defined by at least one of the enterprises for negotiation and incorporation into a negotiated meta-model.”***

By contrast, the portion of *Notani* on which the Examiner relies merely discloses, among other things, that a framework may be augmented with new standards for semantic objects, the framework allows for the building of proprietary standards, and those involved in a collaboration may comment on or modify the collaboration. Applicants respectfully submit that this is not analogous to ***“receiv[ing] selections of one or more of the predefined meta-model elements and one or more meta-model elements that is newly defined by at least one of the enterprises for negotiation and incorporation into a negotiated meta-model.”*** More specifically, Applicants respectfully submit that the Examiner misinterprets the fact that a framework may be augmented with new standards, allows for the building of proprietary standards, and allows for commenting and modification of a collaboration as ***actually receiving a selection of one or more meta-model elements that is newly defined by an enterprise that is to be incorporated into a negotiated metamodel.***

Applicants further respectfully submit that while *Notani* fails to expressly disclose these limitations of Claim 1, as discussed above, the portions of *Notani* relied on by the Examiner also fail to inherently disclose these elements. There is also no teaching, motivation or suggestion to render obvious Claim 1 as *Notani*’s disclosure of modifying a framework by allowing proprietary standards to be used does not suggest to one of ordinary skill in the art that it would be obvious to incorporate a newly defined meta-model element into a negotiated meta-model when there are pre-defined meta-model elements available.

While further distinctions exist between Claim 1 and the cited references, some of which have already been made of record, the failure of *Notani* and *Brodsky*, *taken individually or in combination*, to disclose at least the elements of ***“receiv[ing] selections of one or more of the***

predefined meta-model elements and *one or more meta-model elements that is newly defined by at least one of the enterprises for negotiation and incorporation into a negotiated meta-model,*” as discussed in detail above, is more than sufficient to provide a showing that Claim 1 is not rendered obvious by the cited references.

Accordingly, Applicants respectfully request that the rejection of Claims 1-31 under 35 U.S.C. § 103(a) as obvious over *Brodsky* and *Notani* be withdrawn.

**IV. The Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Brodsky-Notani* Combination**

Applicants respectfully submit that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Brodsky* and *Notani*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art;
- and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “**ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.**” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “**factual findings made by Office personnel are the necessary underpinnings to establish obviousness.**” (*id.*). Further, “**Office personnel must provide an explanation to support an obviousness rejection** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the **factual findings necessary to establish obviousness** or even **an explanation to support the obviousness rejection** based on the proposed combination of *Brodsky* and *Notani*. The Office Action merely states that “applying a predefined meta-model and one or more newly defined meta-model elements to Brodsky would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow for quicker collaboration in the case of the predefined meta-model elements and allow for the enterprise to submit a new type of meta-model element in the case of a newly defined element.” (9 July 2010 Non-Final Office Action, pages 10-11). Applicants respectfully disagree and respectfully submit that the Examiner’s conclusory statement is not sufficient to establish the **factual findings necessary to establish obviousness** and is not a sufficient **explanation to support the obviousness rejection** based on the proposed combination of *Brodsky* and *Notani*. **Applicants respectfully request that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.**” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving

the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “***obviousness rejection should include***, either explicitly or implicitly in view of the prior art applied, ***an indication of the level of ordinary skill.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided ***an indication of the level of ordinary skill. Applicants respectfully request that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.*** (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.*** (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicants’ invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain why the difference(s) between the proposed combination of Brodsky, Notani, and Applicants’ claimed invention would have been obvious to one of ordinary skill in the art.*** The Office Action merely states that “[b]ecause technology is rapidly changing the newly defined element allows for a change in the current collaboration that might be required for purposes of speed and accuracy.” (9 July 2010 Final Office Action, page 11). Applicants respectfully disagree and further respectfully request clarification as to how this statement ***explains why the difference(s) between the proposed combination of Brodsky, Notani, and Applicants’ claimed invention would have been obvious to one of ordinary skill in the art.*** Applicants further respectfully submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).



The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicants respectfully submit that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicants’ claimed invention would have been obvious.* For example, the *Examiner has not adequately supported the selection and combination of Brodsky and Notani to render obvious Applicants’ claimed invention.* The Examiner’s unsupported conclusory statements that “applying a predefined meta-model and one or more newly defined meta-model elements to Brodsky would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow for quicker collaboration in the case of the predefined meta-model elements and allow for the enterprise to submit a new type of meta-

model element in the case of a newly defined element,” and “[b]ecause technology is rapidly changing the newly defined element allows for a change in the current collaboration that might be required for purposes of speed and accuracy,” ***does not adequately provide clear articulation of the reasons why Applicants’ claimed invention would have been obvious.*** (9 July 2010 Non-Final Office Action, pages 10-11). In addition, the Examiner’s unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicants’ claimed invention.

Thus, if the Examiner continues to maintain the obviousness rejection based on the proposed combination of *Brodsky* and *Notani*, ***Applicants respectfully request that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines.***

#### **V. Applicants’ Claims are Patentable over *Brodsky* and *Notani***

Applicants respectfully submit that, as discussed above, Claims 1, 11, 21, and 31 are considered patentably distinguishable over *Brodsky* and *Notani* for at least the reasons discussed above in connection with Claim 1.

Furthermore, with respect to dependent Claims 2-10, 12-20, and 22-30: Claims 2-10 depend from Claim 1; Claims 12-20 depend from Claim 11; and Claims 22-30 depend from Claim 21. As mentioned above, each of Claims 1, 11, 21, and 31 are considered patentably distinguishable over *Brodsky* and *Notani*. Thus, dependent Claims 4, 5, 14, 15, 24, and 25 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, Applicants respectfully submit that Claims 1-31 are not anticipated by *Brodsky* and *Notani*. Applicants further respectfully submit that Claims 1-31 are in condition for allowance. Thus, Applicants respectfully request that the rejection of Claims 1-31 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-31 be allowed.

**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

11 October 2010

Date

/Steven J. Laureanti/signed

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